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10/786,709

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Richard F. Dean

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23696 7590 04/01/2011  
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EXAMINER

REGO, DOMINIC E

ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/786,709  
Filing Date: February 24, 2004  
Appellant(s): DEAN, RICHARD F.

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Linda G. Gunderson  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 01/07/2011 appealing from the Office action mailed 07/27/2010.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The examiner is not aware of any related appeals, interference, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of claimed Subject Matter***

The summary of claimed subject matter contained in the brief is correct.

**(6) *Grounds of Rejection to be Reviewed on Appeal***

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,815,795	Iwai	07-1996
6,990,313	Yarkosky	03-2002
2004/0248581	Seki et al.	04-2004

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 22 recites “A machine-readable storage medium”. In the specification (PGPUB), paragraph 0021, recites “ Moreover, as disclosed herein, **a storage medium**

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may represent one or more devices for storing data, including read only memory (ROM), random access memory (RAM), magnetic disk storage mediums, optical storage mediums, flash memory devices **and/or other machine readable mediums for storing information. The term "machine readable medium" includes**, but is not limited to portable or fixed storage devices, optical storage devices, **wireless channels and various other mediums capable of storing**, containing or carrying instruction(s) and/or data". So treating claim 22 as a whole, it is effectively claiming a signal **(wireless channels)**. Signal does not within any of the statutory categories, thus, not statutory (See MPEP 2100, In re Nuijten, Docket no. 2006-1371 (Fed. Cir. Sept 20, 2007)(slip. Op. at 18)). Therefore, Applicant is advised to either eliminate the "wireless channel", delete claim 22, or amend the claim to include the term "non-transitory".

### ***Allowable Subject Matter***

Claims 1,3-10, and 12-21 are allowed.

Claims 1,3-10, and 12-21 are allowed for the reasons presented in the previous action.

### ***(10) Response to Argument***

1. Appellant's arguments with respect to claim 22 have been fully considered but they are not persuasive.

Claim 22

(A) The Appellant argued that (A). The use of the term “storage medium” in the specification is consistent with its plain meaning (See page 5, lines 3-4) and (B). A storage medium belong to one or more statutory classes (See page 7, third paragraph).

**In response to the argument (A)**, the examiner respectfully disagrees with the appellant's argument. The Examiner points to page 4, Paragraph [0013] of Applicant's specification which describes the claims::

[0013] Moreover, as disclosed herein, a storage medium may represent one or more devices for storing data, including read only memory (ROM), random access memory (RAM), magnetic disk storage mediums, optical storage mediums, flash memory devices **and/or other machine readable mediums for storing information**. The term "machine readable medium" includes, but is not limited to portable or fixed storage devices, optical storage devices, **wireless channels and various other mediums capable of storing, containing or carrying instruction(s) and/or data**.

The Examiner submits that based on above high-lighted portions, the use of the term “storage medium” is not consistent with its plain meaning because a wireless channel has the capability of CARRYING instructions and also has the capability of temporarily storing the data during the transmission. Further, above paragraph stated that “and/or other machine readable mediums for storing information” where other machine readable mediums can be a storage medium for storing information where the storing information can be a signal. Signal is not within any of the statutory categories,

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thus non-statutory. Therefore, the Examiner respectfully submits that the rejection of claim 22 under 35 U.S.C. 101 is proper.

**(11) Related Proceeding(s) Appendix**

2. No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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